

Application No.: 10/658,338
Inventor: Bosse
Response to O.A. dated 02/01/2005

Amendments to the Drawings

Examiner objected to FIG. 5A because reference number 22 was pointing to the incorrect part. Upon further review of the specification and other drawings, the Applicant discovered that FIG. 5B also incorrectly utilized reference number 22. Therefore, a replacement sheet showing FIGS. 5A and B is attached hereto, and reference 22 has been renumbered as reference number 24 in both drawings.

Attachment: Replacement Sheet

Annotated Sheet Showing Changes

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REMARKS/ARGUMENTS

Rejection of Claims 1 and 6-8 under 35 U.S.C. §102(b)

Examiner has rejected Claims 1, 2 and 6-8 under 35 U.S.C. §102(b) as being anticipated by Allen (D272,712) (hereinafter referred to as "Allen"). In order for a claim to be anticipated by a prior art reference under 35 U.S.C. §102(b), all elements of the claim must be present in the reference. "A claim is anticipated only if each and every element in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1015, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Company, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). MPEP 2131.

The Applicant takes issue with the Examiner's description of the invention in the Allen patent on several points. First, the Examiner states that the lock cutting tool in Allen is generally a rectangular, flat plate having leading and trailing edges (5) and top and bottom surfaces. Applicant respectfully disagrees with the Examiner's description of the Allen tool having a "trailing edge." In the Allen patent, the "trailing edge" number (5) as referred to by the Examiner is in fact an upward turned end or an extension of the bar and would not be described as a trailing edge.

The second aspect of the Examiner's description of the Allen tool that the Applicant disagrees with is the description of the "bar (2) being joined to the lock cutting tool generally between the leading and trailing edges, said bar being angled away from the top surface and extending rearward from the lock cutting tool." Applicant argues that the bar (2) on the Allen tool is not joined to the

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lock cutting tool (3) between the leading (4) and trailing (5) edges, but in fact is connected directly to what the Examiner has identified as the trailing edge. Applicant argues that this is an important distinction as the Allen tool does not provide for a space between the trailing edge (5) and the bar (2) and thus is not capable of accommodating a metal bar, such as a security bar. (See Fig. 9 in the Applicant's patent application.) The Applicant's tool is specifically designed so that the bar is connected generally between the leading and trailing edge, so that it can accommodate a metal bar in the space between the bar and the trailing edge. This element of claim 1 is not present in Allen. Moreover, the bar (2) is not angled away from the top surface and even more clearly does not extend rearward from the lock cutting tool. Instead of being angled "away" from the top surface the bar and the lock cutting tool in Allen are connected in a perpendicular relationship. This perpendicular connection also prevents the bar from being directed toward the rear and thus it is not "extending rearward" as is required by claim 1.

Since all the elements of claim 1 of the instant application are not found in Allen, Applicant respectfully requests that this ground of rejection be withdrawn. Since claims 2 and 6-8 depend from claim 1 and include all of the limitations of the independent claim, Applicant respectfully requests that this ground of rejection be withdrawn from these claims also.

Rejection of Claims 1-13 Under 35 U.S.C. §103(a)

The Examiner has rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Gue (3,468,657) (hereinafter referred to as "Gue") in view of Gallo (6,308,934) (hereinafter referred to as "Gallo"). The remaining claims which are all dependent upon claim 1 were all rejected on a

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combination of Allen and/or Gue and Gallo, plus an additional reference. Therefore, the Applicant will first address the §103(a) arguments specifically directed to claim 1 and will subsequently address the following references for the additional claims.

As admitted by the Examiner, Gue fails to disclose the lock cutting tool, a generally rectangular, flat plate joined to the bar between its leading and trailing edges. Applicant argues that Gallo also fails to disclose this feature. The lock cutting tool (18) shown in Gallo is not joined to the elongated bar (12) between its leading and trailing edges. Gallo discusses how the lock cutting tool (or the first pry section as it is referred to in the Gallo patent) is in fact a continuation of the bar. The Gallo patent states, "The distal end of slide bar 12 adjacent to and to the outside of first stop 14 is formed with a first pry section 18 as a continuation thereof and which tapers down in thickness (emphasis added)...." Additionally, in the claims of Gallo, this point is further emphasized in that the first pry section is stated to be at a first end of said elongated linear section (or the bar). It is clear from the language and the drawings in Gallo that the lock cutting tool (or first pry section) is not connected to the bar between any leading and trailing edge. In fact, the only edge mentioned on the first pry section is the front edge, because like Allen, the Gallo tool does not have a trailing edge, but is rather merely an extension formed from the bar.

The Applicant's application provides a specific reference to the importance of having the bar connect between the leading and trailing edge on the lock cutting tool. By allowing for a space between the trailing edge and the bar, the Applicant's tool is able to accommodate a metal bar such as a metal window or door security bar, making the lock removal tool useful for removing such security

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bars. (See Application page 12, lines 3 through 6 and Fig. 9). The feature is only accomplished by having the claimed features present in claim 1, which includes having a lock cutting tool with leading and trailing edges, a bar being joined to the lock cutting tool generally between the leading and trailing edges and said bar being angled away from the top surface and extending rearward from the lock cutting tool. Only with this combination of elements is the Applicant's tool able to provide a space which is defined by the trailing edge, the bar and the first impact collar which can accommodate a metal bar. This feature enabled by Applicant's unique tool design is not suggested or taught by Allen, Gue or Gallo. More importantly, no prior art reference cited by the Examiner teaches or even suggests the use of a lock cutting tool which can accommodate a metal security bar.

The additional §103(a) rejections on the various dependent claims all rely on a combination of a new reference with Allen or with Gue and Gallo. As the Applicant has responded to the Examiner's arguments on both the Allen reference and the combination of the Gue and Gallo references, additional arguments discussing the new references cited in the additional §103(a) rejections are not necessary. However, Applicant does wish to state that the additional references of Skamser (D153,182), Kraus (4,235,269), Lampe (6,213,527), Harpell (6,098,292) are not related to lock removal tools in any way. There is no teaching or suggestion in any of these references which would suggest that the specific feature identified in each reference be combined with a slide-hammer impact tool.

Applicant urges that the aforementioned references and allegations do not establish a *prima facie* case of obviousness under 35 USC §103(a). "The examiner bears the initial burden of factually

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supporting any *prima facie* conclusion of obviousness." MPEP 2142. Thus, Examiner must follow the criteria necessary to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine referenced teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claimed limitations. MPEP 2143.

Applicant urges that the above criteria have not been met in regard to the instant invention.

Examiner has put forward no evidence beyond conclusory statements of conventionality that suggest modifying the reference or finding success in the modification and has not relied directly on the teachings therein. Furthermore, the ability to modify the reference does not necessarily establish a *prima facie* case of obviousness.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680; 16 USPQ 2d 1430 (Fed. Cir. 1990); MPEP 2143.01.

The Examiner has failed to cite any explicit disclosure of the possibility that Allen, Gue and Gallo could be combined with the other cited references could be combined but has rather relied on the teachings of the present application as the motivation to modify. Such use of Applicant's own disclosure is expressly prohibited and inappropriate in a 35 U.S.C. §103 rejection. "The teaching or suggestion to make the claim combination and the reasonable expectation of success must be both found in the prior art, not in Applicant's disclosure." In re Vaeck, 947 F2d 488 (Fed. Cir. 1991). The prior art items themselves must suggest the desirability and thus the obviousness of making the

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combination without the slightest recourse to the teachings of the patent application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation, which is not the standard with which obviousness is determined.

Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F2d 1200 (Fed. Cir. 1991).

The Examiner has thus used impermissible hindsight reconstruction, taking the direct teachings of the present application and filling in the gaps, which are neither evident nor even remotely suggested in the cited references. Impermissible hindsight must be avoided, and the legal conclusion of obviousness must be reached on the basis of the facts gleaned from the prior art. (See MPEP §2142).

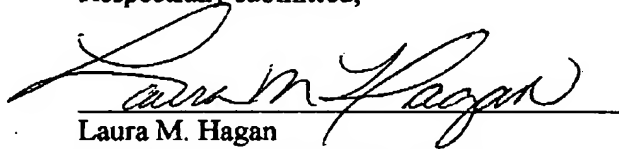
Therefore, Applicant urges that the criteria for establishing a *prima facie* case of obviousness have not been met by the rejection of claims 1-13. The claimed invention, as claimed in claim 1, a cutting tool with both a leading and trailing edge, which has a bar connected generally between the leading and trailing edge and said bar being angled away from the top surface of the cutting tool and extending rearward from the lock cutting tool is not disclosed, taught or suggested in Allen or the combination of Gue and Gallo. Thus, Applicant respectfully requests that Examiner withdraw this basis of rejection of claim 1. Claims 2-13 all depend from claim 1 and include all of the limitations of the independent claim; therefore, Applicant respectfully requests these grounds of rejection be withdrawn.

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Conclusion

Applicant states that claims 1-13 should all be allowed and thus, Applicant respectfully requests Examiner to reconsider the Application and to pass the present Application to allowance. However, if Examiner believes that unresolved issues remain in this case, Applicant respectfully requests Examiner contact Applicant's attorney of record listed below.

Respectfully submitted,



Laura M. Hagan
KERRICK, STIVERS & COYLE, P.L.C.
1025 State Street
P. O. Box 9547
Bowling Green, KY 42102
(270) 782-8160
Reg. No.: 38,902

Attachments

Amdt. dated April 29, 2005
Reply to Office action of Feb. 1, 2005
Annotated Sheet Showing Changes

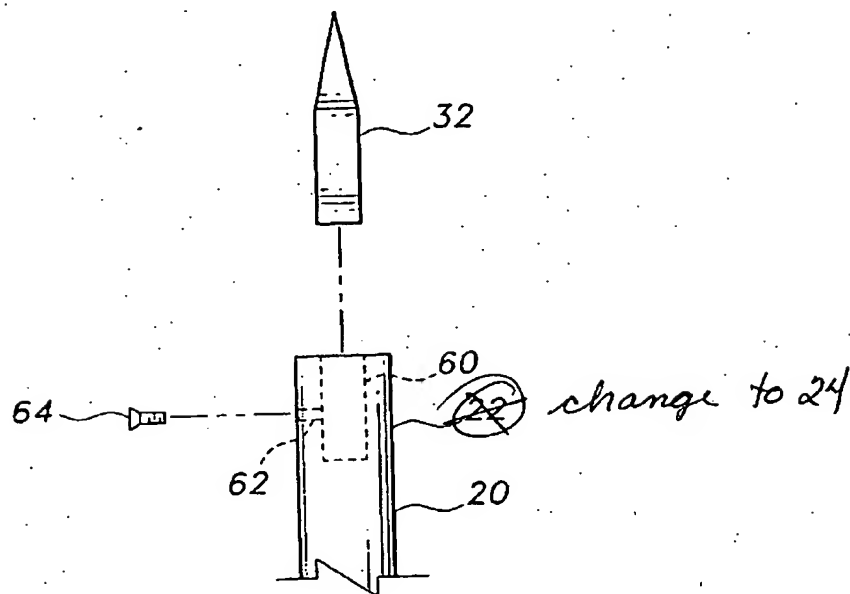


FIG. 5A

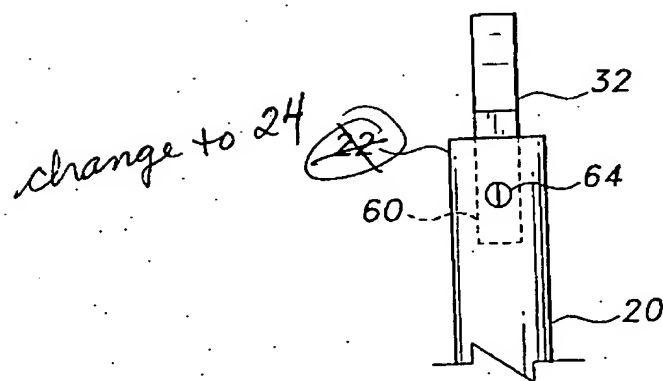


FIG. 5B